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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,924	02/28/2002	John J. Koresko V	10717-1U1	1681

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

KARMIS, STEFANOS

ART UNIT PAPER NUMBER

3624

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,924

Applicant(s)

KORESKO, JOHN J.

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

DETAILED ACTION

1. The following application has been reviewed. Original claims 1-36 are pending. The rejection is as stated below:

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 8-9, 11-13, 15-16, 18-24, 26-27, 29-31, 33-34 and 36 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Parsons U.S. Patent 6,411,939.

Regarding claims 1-5, 12, 19-23, and 30, Parsons discloses a computer-implemented data-processing method for creating a defined benefit pension plan funded using variable life insurance contracts or annuity contracts, by entering, via at least one user interface, actuarial data used to create the defined benefit pension plan, based on the actuarial data, electronically generating a variable life insurance policy used to fund the defined benefit pension plan (column 21, lines 24-43, column 11, lines 43-60 and column 12, line 61 thru column 13, line 10); electronically generating a separate agreement the extra-contractually modifies the variable life

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insurance policy and defines the terms of the agreement (column 19, line 66, thru column 20, line 19, column 25, lines 15-28, Figure 7).

Claims 6, 13, 24 and 31, determining a negotiated guarantee rate of return for the defined benefit pension plan (column 24, lines 15-27).

Claim 8, 15, 26, and 33, the life insurance policy is a variable life insurance policy and the annuity policy is a variable annuity policy (column 44, lines 46-65).

Claim 9, 16, 27 and 34, electronically generating a software illustration associated with the selected policy based on information received from at least one remotely located processor that processed the actuarial data (column 166, lines 43-64).

Claim 11, 18, 29 and 36, allocating funds contributed to the defined benefit pension plan between a General Account and a Variable Account (column 43, lines 7-45).

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 7, 10, 14, 17, 25, 28, 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons U.S. Patent 6,411,939 in view of Burgess U.S. Patent 5,996,693.

Claims 7, 14, 25 and 32, Parsons teaches determining a negotiated guarantee rate of return for the defined benefit pension plan (column 24, lines 15-27). Parsons fails to teach determining, after a predetermined period of time, whether earnings based on funds contributed to the defined benefit pension plans exceed the guaranteed rate of return, and if so, setting an earnings parameter to determine future contributions to the defined benefit pension plan.

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Burgess teaches method for combining loans with employee life insurance in which after a predetermined period of time, determining whether earnings based on funds contributed to the defined benefit pension plans exceed the guaranteed rate of return, and if so, setting an earnings parameter to determine future contributions to the defined benefit pension plan (column 7, line 22 thru column 8, line 7).

Therefore, it would have been obvious to one of ordinary skill in the art that the teachings of Parsons could be modified to include determining whether earnings based on funds contributed to the defined benefit pension plans exceed the guaranteed rate of return, and if so, setting an earnings parameter to determine future contributions to the defined benefit pension plan as taught by Burgess because it provides a proven manner to determine future contributions. There is sufficient motivation to combine the concepts in both Parsons and Burgess, both applications possess computer-implemented process for tying benefit plans to life insurance.

Claim 10, 17, 28 and 35, Parsons teaches a defined benefit pension plan which includes the selected policy and the separate agreement (column 21, lines 24-43, column 11, lines 43-60 and column 12, line 61 thru column 13, line 10). Parsons fails to teach the benefit pension plan is a variable 412(i) defined benefit pension plan. Official Notice is taken that there are 412(i) pension plans are old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Parsons to include 412(i) benefit pension plans because it is a common and familiar type of benefit plan utilized when creating such plans for customers.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Edelman, US Patent 6,085,174, Jul. 4, 2000. Computer assisted and/or implemented process and architecture for administering an investment and/or retirement program.
- b) Burke, US Patent 6,473,737, Oct. 29, 2002. System, method and apparatus for providing an executive compensation system.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

Respectfully Submitted
Stefano Karmis
November 6, 2003


HANI M. KAZIMI
PRIMARY EXAMINER